UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,637	03/13/2002	Slim Souissi	024827-1201	7391

30542 7590 08/23/2007
FOLEY & LARDNER LLP
P.O. BOX 80278
SAN DIEGO, CA 92138-0278

EXAMINER	
HASHEM, LISA	
ART UNIT	**PAPER NUMBER**
2614	
MAIL DATE	**DELIVERY MODE**
08/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/098,637	SOUISSI ET AL.	
	Examiner	Art Unit	
	Lisa Hashem	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8-2-07*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see RCE, filed 8-2-07, with respect to the rejection(s) of claim(s) 1-4, 6-8, 10-12, and 14-22 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see the rejection(s) below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 recites the limitation "the communication device" in lines 7, 9, and 11. There is insufficient antecedent basis for this limitation in the claim. It is not clear if 'the communication device' depends on the communication device in line 1 or line 3.

4. Claim 17 recites the limitation "the communication device" in lines 7-10 and 12. There is insufficient antecedent basis for this limitation in the claim. It is not clear if 'the communication device' depends on the communication device in lines 1-2 or line 4.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 6-8, 10, 11, 14-17, 20, and 22 are rejected under 35 U.S.C. 102(e) as being unpatentable by U.S. Patent No. 6,625,460 by Patil.

Regarding claim 1, Patil discloses a method for complete message delivery, comprising:

receiving a message notification (i.e. SMS message) through a first communication network (Fig. 3, 36; col. 1, lines 24-29 and lines 40-41; col. 3, lines 10-37), the message notification corresponding to a complete message (i.e. content; information) (col. 4, lines 14-18; col. 7, lines 53-57; col. 8, lines 10-14);

connecting to a message server (Fig. 3, 40) through a second communication network (Fig. 3, 50; col. 4, lines 5-9);

parsing the message notification (i.e. SMS message),

prior to downloading the complete message, to determine a set of parameters pertaining to the complete message (col. 7, line 65 – col. 8, line 20);

comparing the set of parameters to an established criteria (i.e. time, updates) for retrieving complete messages; and downloading the complete message if the set of parameters satisfies the established criteria (col. 8, lines 25-49; col. 9, lines 15-40).

Regarding claim 2, the method of claim 1, wherein Patil further discloses the message notification is a mobile terminated SMS message (col. 4, lines 14-18; col. 7, lines 53-57; col. 8, lines 10-14).

Regarding claim 6, the method of claim 1, wherein Patil further discloses the set of parameters comprises a sender and a subject (col. 7, line 53 – col. 8, line 49).

Regarding claim 7, the method of claim 6, wherein Patil further discloses the set of parameters further comprises a priority (col. 7, line 53 – col. 8, line 49; col. 8, lines 15-40).

Regarding claim 8, the method of claim 1, wherein Patil further discloses the set of parameters comprises a unique message identifier (col. 7, line 53 – col. 8, line 49).

Regarding claim 10, Patil discloses a method for complete message delivery to a communication device (i.e. message server; Fig. 3, 40), comprising:

receiving a complete message (i.e. content, information) addressed to a communication device (i.e. pager) (col. 7, line 28 – col. 8, line 9);

constructing a message notification (i.e. SMS) corresponding to the complete message, the message notification including a set of parameters for comparison to an established criteria (i.e. times, updates) for retrieving complete messages (col. 4, lines 14-18; col. 7, lines 53-57; col. 8, lines 10-14; col. 8, lines 25-49; col. 9, lines 15-40);

sending the complete message to the communication device (i.e. message server) through a first communication network (Fig. 3, 36; col. 1, lines 24-29 and lines 40-41; col. 3, lines 10-37);

receiving a download request from the communication device (i.e. message server) based on the comparison of the set of parameters to the established criteria (col. 7, line 65 – col. 8, line 20; col. 8, lines 25-49; col. 9, lines 15-40); and

sending the complete message to the communication device through a second communication network (col. 8, lines 25-49; col. 9, lines 15-40).

Regarding claims 11 and 14-16, please see the rejections to claims 2 and 6-8 above, respectively, to reject the method in claims 11 and 14-16.

Regarding claim 17, Patil discloses a system for complete message (i.e. content, information) delivery to a communication device (Fig. 3: 70A-70n; i.e. pager, fax machine), comprising:

a first communication network (Fig. 3, 50) and a second communication network (Fig. 3, 51) (col. 4, lines 4-26);

a communication device (Fig. 3, 40) adaptable to communicate over the first communication network and the second communication network;

a message control module (Fig. 7, 100) configured to receive a complete message addressed to the communication device (i.e. Fig. 3, 70A-70n) (col. 9, lines 24-40); and

a message filter (Fig. 7, 120) configured to screen the complete message prior to notifying the communication device of the complete message (col. 9, lines 24-40), wherein the notifying of the communication device of the complete message occurs when the complete message passes the message filter and includes a set of parameters (i.e. specific content requested; address of communication device; time; updates), and thereafter providing the complete message to the communication device upon request, the request being generated based on a comparison of the set of parameters with an established criteria (i.e. time; updates) for retrieving complete messages (col. 7, line 65 – col. 8, line 20; col. 8, lines 25-49; col. 9, lines 15-40).

Regarding claim 20, the system of claim 17, wherein Patil further discloses the message control module notifies the communication device of the complete message via the second communication network (Fig. 3, 51) (col. 8, lines 4-9; col. 9, lines 27-30).

Regarding claim 22, the system of claim 17, wherein Patil further discloses the complete message is provided to the communication device via the second communication network (Fig. 3, 51) (col. 8, lines 4-9).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patil as applied to claim 1 above, and in further view of Katz.

Regarding claim 3, the method of claim 2, wherein Patil does not disclose the SMS message is encrypted.

Katz discloses a method for complete message delivery to a multi-mode communication device, comprising: receiving a message notification that is a SMS message and is encrypted (section 0090, line 1 – section 0091, line 38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Patil to include SMS encryption as taught by Katz. One of ordinary skill in the art would have been lead to make such a modification since encrypting a SMS message to allow an authorized user to receive a message notification.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patil, as applied to claim 1 above, and in further view of Mousseau.

Regarding claim 4, the method of claim 1, wherein Patil do not disclose the connecting step comprises establishing a secure VPN connection.

Mousseau discloses a method for complete message delivery to a multi-mode communication device (Fig. 1, 100) (see Abstract), comprising: receiving a message by establishing a secure VPN connection (section 0037, line 1 – section 0039, line 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Patil to include VPN as taught by Mousseau. One of ordinary skill in the art would have been lead to make such a modification since VPN provides security in downloading messages to the communication device, wherein authorized users can view messages.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patil as applied to claim 10 above, and in further view of Katz.

Regarding claim 12, please see the rejection to claim 3 above, respectively, to reject the method in claims 12.

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patil, as applied to claim 17 above, and in further view of Bertacchi.

Regarding claim 18, the system of claim 17, wherein Patil does not disclose a database adaptable to store a registration status pertaining to the communication device, wherein the communication device reports the registration status to the message control module and the message control module updates database.

Bertacchi discloses a system for complete message delivery to a multi-mode communication device (Fig. 1, 10), comprising:

a first communication network or first area and a second communication network or second area;

a communication device adaptable to communicate over the first communication network and the second communication network (col. 4, lines 16-40);

a message control module or message center (Fig. 1, 22) configured to receive a complete message addressed to the communication device, notify the communication device of the message, and provide the complete message to the communication device (col. 1, lines 23-41; col. 4, lines 16-26).

Wherein Bertacchi further discloses a database (Fig. 2, 20: HLR) adaptable to store a registration status pertaining to the communication device, wherein the communication device reports the registration status to the message control module and the message control module updates the database (col. 7, line 62 – col. 8, line 16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Patil to include the communication device reports the registration status to the message control module and the message control module updates the database as taught by Bertacchi. One of ordinary skill in the art would have been lead to make such a modification since the message control module can update the database regarding the registration status based on the communication device reporting its status to the message control module.

12. Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patil, as applied to claim 17 above, and in further view of Sofer.

Regarding claim 19, the system of claim 17, wherein Patil does not disclose the message control module notifies the communication device of the complete message via the first communication network.

Sofer discloses a system for complete message delivery to a communication device (Fig. 2, 16), comprising:

a first communication network (Fig. 2, 36) and a second communication network (Fig. 2, 14);

a communication device (Fig. 2, 16) adaptable to communicate over the first communication network and the second communication network;

a message control module (Fig. 2, 26) configured to receive a complete message addressed to the communication device; and

thereafter providing the complete message to the communication device upon request (col. 6, lines 12-15; col. 7, lines 18-27).

Wherein Sofer further discloses the message control module notifies the communication device of the complete message via the first communication network (Fig. 2, 36) (col. 8, lines 40-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Patil to include notifying the communication device via the first communication network as taught by Sofer. One of ordinary skill in the art would have been lead to make such a modification to provide a communication device that is accessible via a first communication network.

Regarding claim 21, the system of claim 17, wherein Patil does not disclose the complete message is provided to the communication device via the first communication network.

Sofer discloses a system for complete message delivery to a communication device (Fig. 2, 16), comprising:

a first communication network (Fig. 2, 36) and a second communication network (Fig. 2, 14);

a communication device (Fig. 2, 16) adaptable to communicate over the first communication network and the second communication network;

a message control module (Fig. 2, 26) configured to receive a complete message addressed to the communication device; and

thereafter providing the complete message to the communication device upon request (col. 6, lines 12-15; col. 7, lines 18-27).

Wherein Sofer further discloses the complete message is provided to the communication device via the first communication network (Fig. 2, 36) (col. 7, lines 18-34; col. 9, lines 42-49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Patil to include the complete message is provided to the communication device via the first communication network as taught by Sofer. One of ordinary skill in the art would have been lead to make such a modification to provide a communication device that is accessible via a first communication network.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

14. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

lh
August 15, 2007